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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,598	11/20/2001	Frank R. George	425282000201	1393
20872	7590	08/13/2004	EXAMINER	
MORRISON & FOERSTER LLP 425 MARKET STREET SAN FRANCISCO, CA 94105-2482			JASTRZAB, JEFFREY R	
			ART UNIT	PAPER NUMBER
			3762	
DATE MAILED: 08/13/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,598

Applicant(s)

GEORGE ET AL.

Examiner

Jeffrey R. Jastrzab

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 29-33 and 50-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 29-33 and 50-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

Claims 1 , 5-9, 16, 29, 31-33 and 50-53 stand and Claims 54 and 55 are rejected under 35 U.S.C. 102(b) as being anticipated by Tepper '401.

Applicants argue with respect to independent Claim 1 that Tepper fails to show every element in the claims in that the reference does not disclose a “detector on the applicator” but instead teaches that the detector is in the control electronics.

This is not deemed to be persuasive. As shown in Figure 3 of Tepper, there is a separate coil used for sensing, i.e. the windings without cross-hatching as shown. Clearly this sense coil does the actual detection or pick-up, and any further processing such as amplification, comparison to a threshold, etc. would be done by the control electronics which are remote from the sense coil. See also Figure 4, wherein the sensing coil 73 (noted as 74 in the specification) is shown outside the control electronics.

As to Independent Claims 29 and 50, Applicant argues, with respect to the feedback loop in Tepper, that the reference fails to teach the concept of varying the applied energy as a function of the response signal, or detected field and that merely providing feedback does not inherently provide input for control.

This too is not deemed to be persuasive, notwithstanding the fact that it is virtually universal to use feedback loops to control stimulation, there are numerous instances in Tepper that indicate that the feedback is used for control. For example, the control electronics are said to be used for “controlling the activation of the magnetic

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fields (field strength and duty cycle)", and the secondary winding is "used to tailor the parameters of the electromagnetic field", col. 2 at 56-68. How else would the controller know that "tailoring of the electromagnetic field output", col. 4 at 40-41, is necessary if not for the feedback from the sensing coil? This is further amplified with the statements that the "field sense amplifier is used to sense the resulting electromagnetic fields...and provide an appropriate signal to the PEMF processor", col. 7 at lines 32-35, and " the field sense amplifier senses the electromagnetic fields generated during activation, and provides feedback to the PEMF processor for monitoring the PEMF operation", column 8 at 38-45. If the controller is to keep the applied fields in the desired range as programmed, clearly it is this monitoring that enables the required signal tailoring. As a side note, even if Tepper only used feedback for the alarm function as argued, it is inherent that an abnormally high and beyond-a-safe-level field feedback indication would cause the control electronics to disable the applied field, which again amounts to controlling the applied energy as a function of the response signal (feedback).

This rejection is therefore made FINAL.

Claim Rejections - 35 USC § 103

Claims 2-4 and 30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Tepper for the reasons of record.

Claims 10-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Tepper in view of Singh et al. for the reasons of record.

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Since Applicant's arguments regarding the rejections under 35 USC 103(a) revolve around the above 102(b) issues, no further comment is deemed necessary for these rejections. These rejections are therefore made FINAL.

Claim Rejections - 35 USC § 112

The rejection of Claim 10 is withdrawn based on Applicant's remarks.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Jastrzab whose telephone number is (703) 308-2097. The examiner can normally be reached on Monday - Friday 5:30a.m. to 2:00p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela D. Sykes can be reached on (703) 308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeffrey R. Jastrzab
Primary Examiner
Art Unit 3762

8/18/04